

REMARKS

Claims 40 - 44 are currently pending and under examination. Claims 40 - 44 stand rejected. By this Amendment, claim 40 has been amended. Accordingly, upon entry of this Amendment, claims 40 – 44, as amended, will be pending and under examination. Claim 40 is independent.

Claim 40 has been amended to clarify that the signal generating moiety is selected from the group consisting of a fluorescent agent, a chemiluminescent agent, an enzyme and an enzyme substrate. Support for this amendment may be found *inter alia* in the subject application, as originally filed, at page 52, line 22 through page 53, line 1.

Rejection Under 35 U.S.C. § 112, Second Paragraph

Page 2 of the April 23, 2007 Office Action states that claims 40-44 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Specifically, the Office Action states that claim 40 is vague and indefinite in view of step (b) (iii) because it is unclear what kind of signal is inhibited. Without conceding either the correctness of the position stated in the Office Action or the need for amendment for patentability reasons, Applicants have amended claim 40 to clarify that the signal generating moiety is selected from the group consisting of a fluorescent agent, a chemiluminescent agent, an enzyme and an enzyme substrate. Thus, one of ordinary skill in the art would understand that the signal is fluorescent, luminescent or the product of an enzymatic reaction. Applicants respectfully request that the 35 U.S.C. §112, second paragraph, rejection be withdrawn.

Petition for an Unintentionally Delayed Claim Under 37 CFR 1.78(a)(3)

Applicants submitted a Renewed Petition for an Unintentionally Delayed Claim Under 37 CFR 1.78(a)(3) (the "Petition") on April 23, 2007 to claim benefit to prior-filed applications including Zhang et al. (U.S. Patent No. 5,942,391) ("Zhang"). On July 17, 2007, the Office of Petitions granted the Petition noting that the late claim for benefit of priority under 35 U.S.C. §§ 120 and 365(c) is accepted as being unintentionally delayed. A copy of the Decision on Petition Under 37 CFR 1.78(a)(3) is enclosed for your convenience. Accordingly, the subject application will claim priority to Zhang and thus Zhang will not be available as a 35 U.S.C. §103(a) reference.

Rejection Under 35 U.S.C. § 103(a)

Page 3 of the April 23, 2007 Office Action states that claims 40 - 42 are rejected under 35 U.S.C. §103(a) as being unpatentable over Zhang in view of Wang, et al. (U.S. Patent No. 5,567,583) ("Wang") and Harris (U.S. Patent No. 5,837,469) ("Harris").

Page 8 of the April 23, 2007 Office Action states that claim 43 is rejected as being unpatentable over Zhang in view of Wang and Harris and further in view of Heller (U.S. Patent No. 5,532,129) ("Heller").

Page 10 of the April 23, 2007 Office Action states that claim 44 is rejected as being unpatentable over Zhang in view of Wang, Harris and Heller and further in view of Segev (U.S. Patent No. 5,437,977) ("Segev").

As stated *supra*, Applicants' Petition was granted and the subject application now claims priority to Zhang and thus Zhang is not be available as a 35 U.S.C. §103(a) reference. Applicants respectfully submit that neither Wang nor Harris alone or in combination render

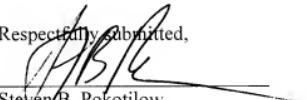
claims 40-42 obvious. Applicants also respectfully submit that neither Wang, nor Harris, nor Heller alone or in combination render claim 43 obvious. Applicants also respectfully submit that neither Wang, nor Harris, nor Heller, nor Segev alone or in combination render claim 44 obvious.

Accordingly, Applicants respectfully request that the 35 U.S.C. § 103(a) rejections be withdrawn.

CONCLUSION

Applicants respectfully submit that this application is in condition for allowance. Early and favorable action is earnestly solicited. No fee, except for the fee in connection with the one month extension fee, is believed due in connection with the filing of this Response. However, if any additional fees are due the amount of such fee may be charged to Deposit Account No. 19-4709.

Respectfully submitted,


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OFFICE OF PETITIONS

In re Application of :
David Y. Zhang :
Application No. 09/978,261 : DECISION ON PETITION
Filed: October 15, 2001 : UNDER 37 CFR 1.78(a)(3)
Attorney Docket No. 251305.0028 SBP/MCD :
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This is a decision on the renewed petition under 37 CFR 1.78(a)(3), filed April 23, 2007, to accept an unintentionally delayed claim under 35 U.S.C. §§ 120 and 365(c) for the benefit of priority to the prior-filed nonprovisional and international applications as set forth in the amendment filed January 25, 2007.

The petition is **GRANTED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) and (iii) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t), and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

All of the above requirements having been satisfied, the late claim for benefit of priority under 35 U.S.C. §§ 120 and 365(c) is accepted as being unintentionally delayed.

The decision on petition mailed March 16, 2007 was incorrect in that it stated that "the amendment improperly states that Application No. 08/596,331 is 'the United States national stage application corresponding to PCT International Application PCT/US95/07671,'" when, in fact, Office records indicate that Application No. 08/596,331 is the National Stage entry of PCT/US95/07671.

Accordingly, the amendment to the specification filed on January 25, 2007 for benefit of priority to the prior-filed applications noted therein is proper and is accepted. However, as the amendment filed

with the renewed petition is now incorrect in indicating that it is a continuation-in-part of the aforementioned PCT application, this amendment is improper and is not accepted. The Office sincerely apologizes for the inconvenience this matter may have caused petitioner.

The granting of the petition to accept the delayed benefit claim to the prior-filed applications under 37 CFR 1.78(a)(3) should not be construed as meaning that this application is entitled to the benefit of the prior-filed applications. In order for this application to be entitled to the benefit of the prior-filed applications, all other requirements under 35 U.S.C. §§ 120 and 365(c) and 37 CFR 1.78(a)(1) and (a)(2) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed applications should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-filed applications noted thereon.

Further, petitioner is advised that, where an application claims a benefit under 35 U.S.C. 120 of a chain of applications, the application must make a reference to the first (earliest) application and every intermediate application. See *Sampson v. Ampex Corp.*, 463 F.2d 1042, 1044-45, 174 USPO 417, 418-19 (2d Cir. 1972); *Sticker Indus. Supply Corp. v. Blaw-Knox Co.*, 405 F.2d 90, 93, 160 USPO 177, 179 (7th Cir. 1968); *Hovlid v. Asari*, 305 F.2d 747, 751, 134 USPO 162, 165 (9th Cir. 1962). See also MPEP § 201.11. In addition, every intermediate application must also make a reference to the first (earliest) application and every application after the first application and before such intermediate application. MPEP Section 201.06(d). Petitioner should review the claim submitted to ensure that a reference is made to the first application and to every intermediate application.

Accordingly, the examiner will, in due course, consider this benefit claim and determine whether this application is entitled to the benefit of the earlier filing date.

A corrected Filing Receipt, which includes the priority claim to the prior-filed applications, accompanies this decision on petition.

Any inquiries concerning this decision may be directed to the undersigned at (571) 272-3218. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

This application is being referred to the examiner of Technology Center Art Unit 1634 for consideration of applicant's entitlement to claim benefit of priority under 35 U.S.C. §§ 120 and 365(c) to the prior-filed applications noted in the amendment filed January 25, 2007.



Frances Hicks
Petitions Examiner
Office of Petitions

ATTACHMENT: Corrected Filing Receipt